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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,518	07/28/2003	Uday V. Deshmukh	PU2148	1517
23454	7590	09/13/2004	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/604,518	Applicant(s) DESHMUKH, UDAY V. 	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/28/03, 7/31/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, drawn to an iron head, classified in class 473, subclass 350.
  - II. Claims 18-20, drawn to a method to manufacture an article, classified in class 473, subclass 409.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of an iron head and a method of making an article are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the iron head can be made by a different process as spraying a coating onto a substrate.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. With respect to claims 1-17, this application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Species 1 (Figs. 1-8): Claim 7.
- b. Species 2 (Figs. 13-20): Claim 2.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3-6, and 8-17 are considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Mr. Michael A. Catania on 8 September 2004 a provisional election was made without traverse to prosecute the invention of an iron head directed to figures 13-20, claims 1-6 and 8-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 and 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

6. Claim 14 is objected to because of the following informalities: Claim 14 depends on itself. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11 and 13-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Buettner.

Buettner discloses an iron head having a body composed of 35-70 percent by weight of nickel, 20 percent by weight of tungsten, and 10-30 percent by weight of chromium (Col. 3, Lns. 25-49). Buettner does not disclose the density or hardness of the material but since it is made of the same composition as that claimed it will inherently have the claimed properties for density ( $9.2$  to  $10 \text{ g/cm}^3$ ) and hardness (Rockwell 80-91).

Alternately one skilled in the art of forming a head with a sufficient covering for heading golf balls would have selected a suitable density and hardness for a covering in which a density of  $9.2$  to  $10 \text{ g/cm}^3$  and a hardness of Rockwell 80-91 are included. It would have been obvious to modify the head of Buettner to have a density of  $9.2$  to  $10 \text{ g/cm}^3$  and a hardness of Rockwell 80-91 in order to have a sufficient energy transferred to a ball at impact.

9. Claims 11 and 16-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen.

Chen discloses an iron (FE, Claim 1) golf club head (Title) having a body composed of 35-60 percent by weight of nickel, 20-30 percent by weight of tungsten, 10 percent by weight of chromium (Abstract) and a density of  $9.2$  to  $10 \text{ g/cm}^3$  (Col. 4, Lns. 23-29). Chen does not disclose the hardness of the material but since it is made of the

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same composition as that claimed it will inherently have the claimed properties for hardness (Rockwell 80-91).

Alternately one skilled in the art of forming a head with a sufficient surface for impacting the ground and golf balls would have selected a suitable hardness for a weight in which a hardness of Rockwell 80-91 is included. It would have been obvious to modify the head of Chen to have a weight with a hardness of Rockwell 80-91 in order to have a sufficient hardness needed for a golf head when impacting a ball or the ground.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buettner in view of Chen.

Buettner lacks 1 weight percent of silicon. Chen discloses silicon added to a Ni-Cr-W alloy to increase flowability of the metal (Abstract) at an amount of less than 1.5% (Col. 4, Lns. 14-15). In view of patent of Chen it would have been obvious to modify the metal alloy of Buettner to include 1 weight percent of silicon in order to increase the flowability of the metal for application to an iron head.

***Allowable Subject Matter***

12. Claims 1-10 are allowed. None of the prior art discloses or renders as obvious a periphery member having a hosel being made of nickel-tungsten-chromium, a central member composed of a non-metal material and having a cavity on a rear surface, and a face plate having a lower density than the material of the periphery member in addition to the other elements of structure claimed.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 10 September 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**